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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,328	09/24/2001	Itsuo Fujiwara	0649-0804P-SP	5333

2292 7590 08/19/2003

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/960,328

Applicant(s)

FUJIWARA ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi et al (Hirabayashi).

Hirabayashi suggests the use of oxazoline compound in column 8, lines 20-25 in a photothermographic material containing photosensitive silver halide, an organic silver salt, reducing agent and binder (abstract). Therefore, Hirabayashi renders the invention as claimed prima facie obvious. Therefore, the reference suggests and makes obvious the claimed subject matter. In re Malagari, 182 USPQ 549.

3. Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hirabayashi et al (Hirabayashi) and Koyama et al (Koyama).

The teaching of Hirabayashi is as taught in the paragraph 4 above. Moreover, the compound having 2-oxazolyl group has been taught in Koyama in column 2 formula A. In column 10, lines 13-30, it is disclosed that the compound is useful in a variety of recording material including thermal sensitive image forming material and silver halide photographic light-sensitive material in term of producing an information recording medium having high resistivity to damage formed before, during and after processing. It would have been obvious to include the compound taught in Koyama in the material of Hirabayashi for same reason, and thereby provide a material as claimed.

***Respons to Arguments***

4. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive for the reason set forth in the previous office action and the advisory action dated May 9, 2003 and July 16, 2003.

The applicants further argue that the present invention containing oxazoline compound with storage stability ( $\Delta D_{min}$ ) as compared to the sample without Oxazoline compound. The mercury salt used in the applied prior art is merely used as an antifoggant. There is no disclosure or suggestion of any affect in improving storage stability. It was argue that they found the improved storage stability ( $\Delta D_{min}$ ) by addition of oxazolidine compound as recited in the present invention.

It is the Examiner's position that the argument is not persuasive. First, it is the Examiner's position that "(A) newly discovered property does not necessarily means the product is unobvious, since this property may be inherent in the prior art. In re Best 195 USPQ 430 (CCPA 1977); In re Swineherd 169 USPO 226 (CCA 1971). Second, the increase of  $D_{min}$  is related to the increase of the fog since the term the fog is associated with the  $D_{min}$ . The use of the antifoggant is to prevent the increase of fog, and therefore, prevent the increase of  $D_{min}$ . It would be expected by the worker of ordinary skill in the art that the sample contains no antifoggant such as presented in the Declaration increase in  $D_{min}$ . Third, it is improper to conclude that the material of the claimed invention provide an unexpected results over the material of the applied prior art of record. The showing of the improvement of  $D_{min}$  alone does not means that the image produced by the claimed material having better quality than that of the applied

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
prior art of record in the absence of providing the Dmax since the image contrast depends on both variables, Dmin and Dmax.

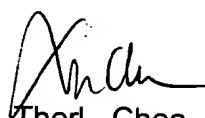
**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea   
August 15, 2003

  
Thorl Chea  
Primary Examiner  
Art Unit 1752